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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,541	02/27/2004	Richard J. Melker	MELK-103	7096

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EXAMINER

STITZEL, DAVID PAUL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/788,541	MELKER, RICHARD J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David P. Stitzel, Esq.	1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 19-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5/10/04; 4/29/05; 11/17/05; 1/5/06.

## OFFICIAL ACTION

### *Restriction/Election*

Receipt of the Applicant's Election of: Invention II, encompassing claims 16-18; herbicides as the patentably distinct species of material; and erthyrosine as the patentably distinct species of temporary visual indicator; which was filed on August 29, 2006, in response to the Official Action dated August 11, 2006, is acknowledged. However, Applicant failed to provide a qualifying statement as to whether the aforementioned election was either "with traverse," or "without traverse." Therefore, since the Applicant did not distinctly and specifically point out any alleged errors in the Examiner's restriction requirement, the election has been treated as an election *without traverse*, pursuant to MPEP § 818.03(a).

### *Status of Claims*

Claims 1-15 and 19-27 are withdrawn from further consideration as being directed to a non-elected invention. As a result, claims 16-18 are therefore examined herein on the merits for patentability.

### *Claim Rejections - 35 U.S.C. § 102*

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102, which forms the basis of the anticipation rejections as set forth under this particular section of the Official Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 16-18 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,429,952 (hereinafter the Garner '952 patent).

With respect to claims 16-18 of the instant application, the Garner '952 patent discloses an agrochemical formulation comprising: a herbicide; and an erythrosine marker compound; wherein said erythrosine marker compound may be employed at different concentrations so as to provide for the qualitative detection of the presence of said herbicidal agrochemical formulation (column 3, lines 1-57; column 4, lines 19-22, 28-31, 38-41, 49, 54 and 55; column 5, lines 7, 8 and 43-60; column 6, lines 40-52, 67 and 68; column 7, lines 1 and 2; column 8, lines 19-29 and 47-50).

Claim 16 of the instant application recites that said erythrosine temporary visual indicator is initially visible and capable of becoming substantially invisible after application of the instantly claimed composition to a surface. As such, said limitation recites an intended future use of said composition and will therefore be given little probative patentable weight. Moreover, a recitation of an intended future use of the claimed invention must result in a patentably distinct difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art composition is capable of performing the intended future use of the claimed invention, then the prior art composition anticipates the claimed invention. Since the Garner '952 patent discloses an agrochemical formulation comprising a herbicide and an erythrosine marker compound, which is identical to that of the instantly claimed invention, the prior art composition is capable of performing the intended future use of the instantly claimed invention. In addition, the claim language drawn to erythrosine being initially visible and capable of becoming substantially invisible after application of the instantly claimed composition to a surface, are mere recitations of inherent physicochemical properties of erythrosine. As a result, the Garner '952 patent anticipates said claim.

The "discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." See *Atlas Powder Co. v. Ireco Inc.*, 51 USPQ 2d 1943, 1947 (Fed. Cir. 1999).

Therefore, merely claiming a new use, new function or unknown property, which is inherently present in the prior art, does not necessarily make the claim patentable. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977); and MPEP § 2112. Furthermore “products of identical chemical composition can not have mutually exclusive properties,” since a chemical composition and its properties are inseparable. See *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); and MPEP § 2112. Therefore, if the prior art teaches the identical chemical composition, the properties applicant discloses and/or claims are necessarily present. See MPEP § 2112.

A rejection under 35 U.S.C. § 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic. See MPEP § 2112. Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the Examiner may make a rejection under both 35 U.S.C. §§ 102 and 103, expressed as a 102/103 rejection. *Id.* “There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. § 103 and for anticipation under 35 U.S.C. § 102.” *In re Best*, 195 USPQ 430, 433 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. See MPEP § 2112. Therefore, a 35 U.S.C. 102/103 rejection is appropriate for these types of claims as well as for composition claims. *Id.* However, the Examiner must provide a rationale or evidence tending to show inherence. *Id.* “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the

determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 103, which forms the basis of the obviousness rejections as set forth under this particular section of the Official Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,429,952 (hereinafter the Garner ‘952 patent).

With respect to claims 16-18 of the instant application, the Garner ‘952 patent teaches an agrochemical formulation comprising: a herbicide; and an erythrosine marker compound; wherein said erythrosine marker compound may be employed at different concentrations so as to provide for the qualitative detection of the presence of said herbicidal agrochemical formulation (column 3, lines 1-57;

column 4, lines 19-22, 28-31, 38-41, 49, 54 and 55; column 5, lines 7, 8 and 43-60; column 6, lines 40-52, 67 and 68; column 7, lines 1 and 2; column 8, lines 19-29 and 47-50).

Although the Garner '952 patent does not explicitly teach that said erythrosine is initially visible and capable of becoming substantially invisible after application of the instantly claimed composition to a surface, as claimed in claim 16, these are mere recitations of inherent physicochemical properties of erythrosine. The "discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." See *Atlas Powder Co. v. Ireco Inc.*, 51 USPQ 2d 1943, 1947 (Fed. Cir. 1999). Therefore, merely claiming a new use, new function or unknown property, which is inherently present in the prior art, does not necessarily make the claim patentable. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977); and MPEP § 2112. Furthermore "products of identical chemical composition can not have mutually exclusive properties," since a chemical composition and its properties are inseparable. See *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); and MPEP § 2112. Therefore, if the prior art teaches the identical chemical composition, the properties applicant discloses and/or claims are necessarily present. See MPEP § 2112.

In addition, although the Garner '952 patent teaches that said erythrosine marker compound is preferably present within said herbicidal agrochemical formulation at concentrations of from about 1 ppb to about 25 ppm, so as to provide a covert means of detecting counterfeit herbicidal agrochemical formulations, the Garner '952 patent also teaches that said erythrosine marker compound may be employed at different concentrations so as to provide for the qualitative detection of the presence of a residue of said herbicidal agrochemical formulation (column 3, lines 31-39; column 4, lines 38-41, 49, 54 and 55; column 5, lines 7, 8 and 43-60; column 6, lines 40-52, 67 and 68; column 7, lines 1 and 2; column 8, lines 19-29 and 47-50).



It would have been prima facie obvious to one of ordinary skill in the art at the time the instant application was filed to modify the herbicidal agrochemical formulation of the Garner '952 patent by increasing the concentration of said erythrosine marker compound contained therein, so as to provide for a means of visibly and readily detecting the presence of a residue of said herbicidal agrochemical formulation on an agricultural crop, as reasonably suggested by the Garner '952 patent (column 3, lines 31-39; column 4, lines 38-41, 49, 54 and 55; column 6, lines 40-52, 67 and 68). One of ordinary skill in the art at the time the instant application was filed would have been motivated to increase the concentration of said erythrosine marker compound contained within said herbicidal agrochemical formulation, so as to provide for a visibly and readily detectable means of ensuring appropriate spreading and effective distribution of said herbicidal agrochemical formulation over an entire agricultural crop during a process of crop-dusting, as reasonably suggested by the Garner '952 patent (column 3, lines 31-39; column 4, lines 38-41, 49, 54 and 55; column 6, lines 40-52, 67 and 68).

With respect to the preferred concentrations of said erythrosine marker compound present within said herbicidal agrochemical formulation as taught in the Garner '952 patent, it is well established that the disclosure of a prior art reference is not limited to working examples or preferred embodiments contained therein. See, *Merck & Co. Inc. v. Biocraft Labs. Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); and *In re Fracalossi and Wajer*, 681 F.2d 792, 794, 215 USPQ 569, 570 footnote 1 (CCPA 1982). This is particularly evidenced by the fact that the Garner '952 patent also teaches that said erythrosine marker compound may be employed at different concentrations (column 6, lines 40-52).

### ***Conclusion***

Claims 16-18 are rejected because the claimed invention would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made since each and every element of

the claimed invention, as a whole, would have been reasonably suggested by the teachings of the cited prior art references.

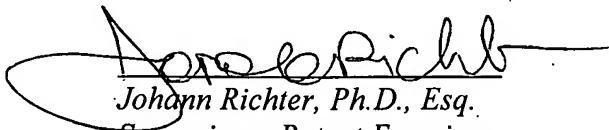
***Contact Information***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq., whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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